



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Makoto TSUDA, et al.

Application No.: 10/676,289

Group No.: 1635

Filed: October 1, 2003

Examiner: Vivlemore, Tracy Ann

For: SCREENING METHOD OF DRUG FOR TREATMENT OF NEUROPATHIC PAIN

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

**TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT
BEFORE MAILING DATE OF EITHER A FINAL ACTION
OR NOTICE OF ALLOWANCE (37 C.F.R. 1.97(c))**

NOTE: 37 C.F.R. 1.97: "(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application, and it is accompanied by one of:

- (1) The statement specified in paragraph (e) of this section; or
- (2) The fee set forth in § 1.17(p)."

NOTE: "If a final action or notice of allowance is mailed in an application and later withdrawn, the application will be considered as not having had a final action or notice of allowance mailed for purposes of considering an information disclosure statement." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10*

(When using Express Mail, the Express Mail label number is **mandatory**;
Express Mail certification is **optional**.)

I hereby certify that, on the date shown below, this correspondence is being:

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37 C.F.R. 1.8(a)

37 C.F.R. 1.10* (Preferred)

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TRANSMISSION

transmitted by facsimile to the Patent and Trademark Office, to (703) 872-9306

Date: December 22, 2004

Signature

Janet I. Cord

(type or print name of person certifying)

* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

NOTE: 37 C.F.R. § 1.704(d): "A paper containing only an information disclosure statement in compliance with §§ 1.97
12/29/2004 ZJUHAR1 00000084 10676289

02 FC:1806

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(Transmittal of Information Disclosure Statement before Mailing Date of Either a Final Action Or Notice of Allowance—page 1 of 3) 6-4

and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable."

NOTE: *"If information submitted during the period set forth in 37 C.F.R. 1.97(c) with a certification is used in a new ground of rejection on unamended claims, the next Office action will not be made final since in this situation it is clear that applicant has submitted the information to the office promptly after it has become known and the information is being submitted prior to a final determination on patentability by the Office. However, the information submitted with a certification can be used in a new ground of rejection and the next Office action made final, [i]f the new ground of rejection was necessitated by amendment of the application by applicant. Where the information is submitted during this period with a fee, the examiner may use the information submitted, e.g., printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP 706.07(a). If a new ground of rejection is introduced that is neither necessitated by an amendment to the claims nor based on the information submitted with the fee set forth in 37 C.F.R. 1.17(p), the Office action shall not be made final. Notice of April 20, 1992 (1138 O.G. 37-41, 39).*

WARNING: *"A petition for suspension of action to allow applicant time to submit an information disclosure statement will be denied as failing to present good and sufficient reasons, since 37 C.F.R. 1.97 provides adequate recourse for the timely submission of prior art for consideration by the examiner." Notice of July 6, 1992 (1141 O.G. 63). But see § 103(b) and (c), limited suspension of action in a continued prosecution application (CPA) filed under § 1.53(d) and in a request for continued examination (RCE) under § 1.114.*

WARNING: *No extension of time can be had under 37 C.F.R. 1.136(a) or (b) for filing an IDS. 37 C.F.R. 1.97(f).*

TIME OF TRANSMITTAL OF ACCOMPANYING INFORMATION DISCLOSURE STATEMENT

1. The information disclosure statement transmitted herewith is being filed **after** three months of the filing date of this national application or the date of entry of the national stage as set forth in § 1.491 in an international application or after the mailing date of the first Office action on the merits, whichever event occurred last but **before** the mailing date of either:

- (1) a final action under § 1.113 or
- (2) a notice of allowance under § 1.311,

whichever occurs first.

STATEMENT OR FEE

2. Accompanying this transmittal is
(check either A or B below)

A. a statement as specified in 37 C.F.R. 1.97(e).

OR

B. the fee set forth in 37 C.F.R. 1.17(p) for submission of an information disclosure statement under § 1.97(c). (\$180.00).

METHOD OF PAYMENT OF FEE

3. Attached is a check in the amount of \$ _____.

[] Charge Account No. _____ in the amount of \$ _____.
A duplicate of this request is attached.

If any additional **or lesser** fees are due, please charge **or refund deposit** Account 12-0425.


SIGNATURE OF PRACTITIONER

Reg. No. 33,778

Janet I. Cord

(type or print name of practitioner)

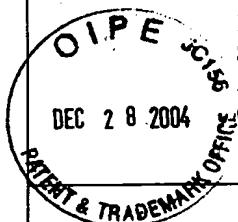
Tel. No.: (212)708-1935

P.O. Address

Customer No.:

c/o Ladas & Parry LLP
26 West 61st Street
New York, N.Y. 10023

FORM PTO-1449		U. S DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		ATTY. DOCKET NO.	SERIAL NO.
				U 014843-4	10/676,289
				APPLICANT	
				Makoto TSUDA, et al.	
				FILING DATE	GROUP
				October 1, 2003	1635



DEC 28 2004 (Use several sheets if necessary)

U.S. PATENT DOCUMENTS

EXAMINER INITIALS	REFERENCE DESIGNATION	DOCUMENT NUMBER	DATE	NAME	FILING DATE IF APPROPRIATE
	AA				
	AB				
	AC				
	AD				
	AE				
	AF				
	AG				
	AH				
	AI				
	AJ				
	AK				

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION	
					YES	NO
	AL					
	AM					
	AN					
	AO					
	AP					

OTHER ART (Including Author, Title, Date, Pertinent Dates, Etc.)

	AR	G. Torres, et al.: "Hetero-oligomeric Assembly of P2X Receptor Subunits" The Journal of Biological Chemistry, 1999, vol. 274, no. 10, pp.6653-6659.
	AS	F. Cavaliere, et al.: "Up-regulation of P2X ₂ , P2X ₄ Receptor And Ischemic Cell Death: Prevention By P2 Antagonists" Neuroscience, 2003, vol. 120, pp 85-98.
	AT	

EXAMINER DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.



JFW

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Attorney Docket No.: U 014843-4

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT

We draw the attention of the Examiner to the attached references which are also listed on the attached Form PTO-1449.

Respectfully submitted,

[Signature]
Janet I. Cord
c/o Ladas & Parry LLP
26 West 61st Street
New York, New York 10023
Reg. No. 33,778 (212) 708-1935

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10*

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Express Mail certification is optional.)*

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37 C.F.R. 1.8(a)

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37 C.F.R. 1.10*

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Janet I. Cord

(type or print name of person certifying)

***WARNING:** Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. 1.10(b).

"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.